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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/933,588

08/21/2001

Dean P. Alderucci

01-023

6856

22927

7590

10/17/2008

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

10/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/933,588

**Applicant(s)**

ALDERUCCI ET AL.

**Examiner**

Yehdega Retta

**Art Unit**

3622

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19, 31-33 and 35-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-19, 31-33 and 35-43 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is responsive to amendment filed July 6, 2007 and also to the Decision on Petition to revive the application. Applicant amended claims 1, 3, 5, 11, 17-19, 31 and 38. Claims 27-30, 34, 44-46 and 48-51 are canceled. Claims 1-19, 31-33 and 35-43 are currently pending.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, drawn to *determining by a point-of-sale terminal comprising a cash register an upsell* based on at least one item purchased by accessing a database, classified in class 705, subclass 14.
- II. Claims 3-4, 11-16 and 38-43, a *processor embodied in a cash register to receive a purchase of an item; determining an upsell based on the item determining a rounded price and providing an offer* classified in class 705, subclass 14.
- III. Claims 5-10, drawn to *receiving, at a point-of-sale terminal a purchase that includes at least one item in which the point-of-sale terminal comprises a cash register*, classified in class 705 subclass 14.
- IV. Claims 17-14, drawn to *selling, at a point-of-sale terminal comprising of cash register , the at least one item and the upsell for the rounded price* if the response indicates acceptance of the offer classified in class 705, subclass 14.
- V. Claims 31-37, drawn to *receiving, at a point-of-sale terminal, a purchase that includes at least one item* in which the point-of-sale terminal comprises a cash register, classified in class 705, subclass 14.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group I has separate utility such as *determining by a point-of-sale terminal comprising a cash register an upsell*. This separate use distinguishes the invention of Group I from Group II-V since this claimed feature is not limitation of those independently claimed inventions. Therefore the invention of Group I is a separately useable subcombination. See MPEP § 806.05(d).

Inventions II and I, III-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group II has separate utility such as a *processor embodied in a cash register to receive a purchase of an item; determining an upsell based on the item determining a rounded price and providing an offer*. This separate use distinguishes the invention of Group II from Group I, III-V since this claimed feature is not limitation of those independently claimed inventions. Therefore the invention of Group II is a separately useable subcombination. See MPEP § 806.05(d).

Inventions III and I-II, IV-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group III has separate utility such as to

*receiving, at a point-of-sale terminal a purchase that includes at least one item in which the point-of-sale terminal comprises a cash register.* This separate use distinguishes the invention of group III from group I, II, IV-V since the claimed feature is not limitation of those independently claimed inventions. Therefore the invention of group III is a separately useable subcombination. See MPEP § 806.05(d).

Inventions IV and I-III, V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group IV has separate utility such as *selling, at a point-of-sale terminal comprising of cash register , the at least one item and the upsell for the rounded price.* This separate use distinguishes the invention of group IV from group I-III, V since the claimed feature is not limitation of those independently claimed inventions. Therefore the invention of group IV is a separately useable subcombination. See MPEP § 806.05(d).

Inventions V and I-IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group V has separate utility such as *receiving, at a point-of-sale terminal, a purchase that includes at least one item.* This separate use distinguishes the invention of group V from group I-IV since the claimed feature is not limitation of those independently claimed inventions. Therefore the invention of group V is a separately useable subcombination. See MPEP § 806.05(d).

Examiner considers that since applicant independently claim the invention of this group, it is prima facie showing that the inventions are intended to be independent and distinct and are shown to be separately usable.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

*Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.*

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/  
Primary Examiner, Art Unit 3622